

REMARKS

Claims 1-21 remain pending and under current examination. Applicant respectfully requests reconsideration of this application in light of the following remarks.

I. Regarding the Final Office Action

In the Office Action¹, the Examiner rejected claims 1, 5-8, 13-16, and 19-21 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,725,649 to Deerfield (“*Deerfield*”); and rejected claims 2, 9, and 10 under 35 U.S.C. 103(a) as being unpatentable over *Deerfield* in view of U.S. Patent No. 4,991,131 to Yeh et al. (“*Yeh*”).

Applicant gratefully acknowledges the Examiner’s indication of allowable subject matter in claims 3, 4, 11, 12, 17, and 18.

Applicant respectfully traverses the Examiner’s rejections for the following reasons.

II. Regarding the rejection of claims 1, 5-8, 13-16, and 19-21 under 35 U.S.C. § 102(b) as being anticipated by *Deerfield*

Applicant respectfully traverses the rejection of claims 1, 5-8, 13-16, and 19-21 under 35 U.S.C. § 102(b) as anticipated by *Deerfield*. In order to properly establish that *Deerfield* anticipates Applicant’s claimed invention under 35 U.S.C. § 102(b), each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” *See* M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

Deerfield does not disclose each and every element of Applicant's claimed invention.

Claims 1, 8, and 16 call for a combination including, for example:

multiplying a subprecise operand and a non-subprecise operand using a plurality of intermediate stages.

Deerfield fails to teach at least this element of claims 1, 8, and 16. In response to Applicant's previous reasoning, the Examiner asserts "the cited reference clearly discloses a multiplication of a normalized and un-normalized operands wherein the normalized operand is the output of 28 (e.g. see col. 4 lines 50-58) and the un-normalized operand is the output of 22" (Office Action at p. 6). Applicant disagrees with the Examiner's assertion. *Deerfield* teaches in col. 4, lines 58-62:

It should be noted that partial products of the unnormalized numbers in the multiplicand register 28 and the multiplier register 22 are produced by the digital multiplier (emphasis added). That is, *Deerfield* explicitly teaches the numbers in both register 28 and 22 are unnormalized, contrary to the Examiner's assertion.

Accordingly, *Deerfield* cannot anticipate claims 1, 8, and 16 for at least the reason that *Deerfield* does not teach or suggest at least "multiplying a subprecise operand and a non-subprecise operand using a plurality of intermediate stages" as recited by claims 1, 8, and 16. Applicant therefore respectfully requests the Examiner to reconsider and withdraw the rejection of claims 1, 8, and 16 as being anticipated by *Deerfield*.

Claims 5-7, 13-15, and 19-21 depend from independent claims 1, 8, and 16, respectively, and therefore include all of the elements recited in their respective independent claims. Therefore, claims 5-7, 13-15, and 19-21 are allowable at least for the reasons discussed above

with respect to claims 1, 8, and 16. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection of claims 5-7, 13-15, and 19-21 as being anticipated by *Deerfield*.

IV. Regarding the rejection of claims 2 and 9-10 under 35 U.S.C. § 103(a) as being unpatentable over *Deerfield* in view of *Yeh*

Applicant respectfully traverse the rejection of claims 2, 9, and 10 under 35 U.S.C. § 103(a) because a *prima facie* case of obviousness has not been established with respect to these claims.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142, 8th Ed., Rev. 2 (May 2004), p. 2100-128.

A *prima facie* case of obviousness has not been established because, among other things, neither *Deerfield* nor *Yeh*, taken alone or in combination, teaches or suggests each and every element of Applicant's claims.

Claims 2, 9, and 10 depend from claims 1 and 8 and therefore include all of the elements recited therein. As noted above, claims 1 and 8 call for a combination including, for example: multiplying a subprecise operand and a non-subprecise operand using a plurality of intermediate stages.

As discussed above, *Deerfield* fails to teach or suggest at least this element. *Yeh* fails to make up for the deficiencies of *Deerfield*. *Yeh* is relied upon for allegedly teaching "a multiplier (46) for multiplying operands (M(X) and M(Y)) using a 3-2 adders array" (Office Action at p. 4).

Even assuming the Examiner's assertion is true, *Yeh* nevertheless fails to teach or suggest at least "multiplying a subprecise operand and a non-subprecise operand using a plurality of intermediate stages," as recited by claim 1 and required by claims 2, 9, and 10.

Because *Deerfield* and *Yeh*, taken alone or combination, fail to teach or suggest each and every element required by claims 2, 9, and 10, no *prima facie* case of obviousness has been established with respect to claims 2, 9, and 10. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection of claims 2, 9, and 10 as being unpatentable over *Deerfield* in view of *Yeh*.

V. Conclusion

In view of the foregoing remarks, Applicant submits that this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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